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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/089,789 06/03/98 SHORT J

HM12/0212

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EXAMINER

MCGARRY, S

ART UNIT

PAPER NUMBER

1635

13

DATE MAILED:

02/12/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/089,789

Applicant(s)

SHORT, JAY M.

Examiner

Sean McGarry

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1/38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1/38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 & 10.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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### DETAILED ACTION

1. The restriction requirement mailed 10/3/00 is moot in view of applicant cancellation of all non-elected claims in the election filed 11/6/00.

2. Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a “process for forming a catalogued nucleic acid library from an organism sample”. The conclusion of the claim does not relate back to the preamble of the claim resulting in a method that does not necessarily relate back to the recited intention of the process.

Claim 1 recites sections (a) (I) and (ii), and (b) (I) and (ii) wherein it is recited “subjecting” or “recovering” a “working example”. A “working example” does not necessarily relate back to the “derived organism sample” or a “derived nucleic acid sample”, and furthermore does the “working sample relate back to the “initial organism sample” or “an initial working sample”, for example.

Claim 1 recites “adjusted to advantage”. It is unclear what is intended with this ambiguous language. The specification does not provide a specific definition and it is not clear what would be encompassed with this limitation. Claims 6, 11, 18, and 26 contain similar concerns.

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Claim 1 recites “the proportional representations of the constituents in said. . .” on lines 4 and 12. There is no antecedent basis for this language in the claim.

Claim 1 has a conclusion that reads “whereby said process provides a means for forming a nucleic acid library...” It is unclear what the intended limitations of this conclusion are intended. It is unclear what in view of the specification and the context of the claim itself what “means” are intended do the method steps recited in the claim provide this “means” or does the method further include such “means”, for example.

Claim 2 recites a process according to claim 1 “wherein performing the step of (a) forming a derived organism sample I comprised of resolving. . .”. It is unclear from the context of the claim whether this step is in addition to steps (I) and/or (ii) or in place of these steps for example. If the new step replaces these then the claim is also failing to further limit the preceding claim. Claims 4, 6, 7, 9, 11, 12, 15, 18, 20, 23, 26, 28, 30, 32-35, 37, and 38 have similar concerns.

Claim 2 recites, on line 3, “the heterogeneity of said initial organism sample” there is no antecedent basis for this limitation in the claim. Claims 4, 6, 7, 9, 11, 12, 15, 18, 20, 23, 26, 28, and 30 have similar concerns

Claim 2 recites, on line 3, “resolving the heterogeneity” it is unclear from the specification and the context of the claims what is embraced in “resolving heterogeneity”. Claims 4, 6, 7, 9, 11, 12, 15, 18, 20, 23, 26, 28, and 30 have similar concerns

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Claim 4 recites “selectively enriched” it is unclear what is intended with this limitation. The specification does not provide a specific definition of “selectively enhanced” and is further confusing in relation to “resolved heterogeneity”. Claims 9, 15, 23, and 30 have similar concerns.

3. The claims as filed are confusing and do not allow a clear interpretation of what steps the method comprises and what is embraced in the terms used throughout the claims. A search has been performed but the applicability of the art to the claimed invention can not be clearly determined in view of the above. Clarification of the claims will allow for a clear determination of the art searched. Applicant representative is invited to telephone the examiner if it is believed a telephone conference would help clarify the claimed invention and expedite the examination of the instant application.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean McGarry whose telephone number is (703) 305-7028.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached on (703) 308-4003.

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. Papers should be faxed to Art Unit 1635 via the PTO Technology Center Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices


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published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see C.F.R. 1.6(d)). The Art Unit 1635 FAX number is (703) 308-4242 or (703) 305-3014. NOTE: If Applicant **does** submit a paper by Fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Sean McGarry

February 6, 2001



SEAN MCGARRY  
PATENT EXAMINER  
TC 1600